

REMARKS

Applicant presents the foregoing amendments to the claims and the following remarks, along with a Request for Continued Examination. Favorable reconsideration of all claims is respectfully requested.

As now presented, claim 1 requires a wall covering including a non-woven fiber tissue or mat and a thermoplastic polymer coating covering the outer side of the non-woven fiber tissue or mat in a continuous fashion to reduce significantly the porosity of the wall covering. The thermoplastic polymer coating further provides a roller paintable, visible outer surface on the non-woven fiber tissue or mat. This continuous coating covering the outer surface of the tissue or mat is also free of random discontinuities that not only increase porosity, but also are susceptible to creating visible irregularities when roller painted. Full support for these limitations may be found in paragraph 6 of the published application, as well as in the drawing figures (see, e.g., Figure 2 illustrating the continuous, uninterrupted coating 54 free from random discontinuities covering the non-woven fiber tissue or mat 52 to thereby significantly reduce the porosity of the wall covering).

The Advisory Action of August 15, 2005 states that U.S. Patent No. 5,876,551 to Jackson discloses a wall covering with a surface that "includes microscopic pores, which provide the gas permeability to the Jackson material." This surface allegedly "do[es] not deviate from the 'regular' surface claimed particularly because the smooth and continuous surface of Jackson read on a 'regular' surface" (emphasis added). For these reasons, the rejections of all claims made in the prior final Office Action based primarily on Jackson are maintained.

Although Applicant respectfully disagrees with the propriety of the rejection, claim 1 as explained above now requires that the thermoplastic polymer coating "covers" the non-woven fiber tissue or mat in a continuous fashion to reduce its porosity. Further, as shown in Applicant's Figure 2, this coating (not just the surface) is free of random discontinuities that, if otherwise present, would substantially increase porosity of the wall covering. As also discussed in more detail in Applicant's specification, the significant

reduction in porosity provided by covering the substrate with such a continuous, uninterrupted layer, as opposed to simply forming an interrupted layer with holes through it, substantially reduces the amount of paint required to form an aesthetically pleasing surface. This is because the paint will not simply leak through the holes in the layer and wastefully become absorbed by the underlying substrate. The practical result is an estimated 50-66% reduction in the amount of paint required (see ¶ 32 of Applicant's published application), which may advantageously allow for the application of only a single coat of paint to the polymeric coating.

In stark and total contrast, Jackson discloses a wall covering having a "porous polymeric ply . . . fused to and supported by a nonwoven substrate ply" (emphasis added). At column 3, lines 51-55, Jackson expressly defines "porous" and "continuous" synonymously as referring to "the existence of a multitude of small holes, openings or gaps in the polymeric ply of the wallcovering," not just its surface. Noteworthy is the fact that Jackson, choosing to be his own lexicographer, selected a definition of the word "continuous" that does not comport with the ordinary meaning of "uninterrupted."¹

Jackson thus does not disclose, teach or otherwise suggest a coating that covers the non-woven mat in a continuous fashion (giving "continuous" its ordinary meaning) and free of random discontinuities, as shown in Applicant's Figure 1. In fact, this reference actually teaches away from such an arrangement by virtue of the critical need for holes in the outer ply of the wall covering (see, e.g., col. 5, lines 45-51, "The key feature of the coating or plastisol application process is that the plastisol is applied very thinly to the nonwoven substrate ply . . . [which] results in small discontinuities, holes, or gaps, which upon fusion form miniature holes or pores in the fused polymeric ply" (emphasis added)). Jackson is also completely silent as to whether the polymeric ply covers the nonwoven substrate in a manner that would in any way facilitate painting (not printing),

¹ Intellicall, Inc., v. Phonometrics, Inc., 952 F.2d 1384, 1388, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992) ("An inventor may "be his own lexicographer and . . . give terms uncommon meanings."), but cf. Jonsson v. Stanley Works, 903 F.2d 812, 820, 14 USPQ2d 1863, 1871 (Fed. Cir. 1990) ("[w]ords in a claim ... [are] given their ordinary and accustomed meaning.")

including by way of a roller. Accordingly, claim 1 as amended is believed to distinguish over Jackson.

The final Office Action preceding the above-referenced Advisory Action also maintained the rejection of claims 23-35 based primarily on Jackson "as further evidenced by" the Abstract of WO 95/07946. However, neither reference discloses, teaches, or suggests the invention of claim 23 as a whole, including a layer of paint roller-applied to a thermoplastic polymer coating applied to a non-woven fiber tissue or mat. Since this express element of claim 23 is apparently disregarded in the formulation of the final rejection, favorable reconsideration of claim 23 is requested.

Despite including all limitations of an allowable base claim, the independent patentability of several of the claims depending from claim 23 over Jackson and the other cited references is also emphasized. For example, dependent claim 24 requires that the outer surface of the polymer coating has a surface tension of at least approximately 30 dynes/cm. In the final Office Action, it is acknowledged that Jackson is completely silent as to the claimed surface tension, and no other reference is cited as allegedly supplying this missing teaching. However, it is allegedly "reasonable to presume" that the "claimed properties" are "inherent" in the material disclosed in Jackson.

This naked assertion is contrary not only to the Manual of Patent Examining Procedure, but also precedential decisions holding that "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."² Not only do the steps described for forming the Applicant's claimed wall covering differ completely from those outlined in Jackson, but Applicant's processing involves a treatment designed to impart a particular surface tension in order to facilitate roller painting. As acknowledged in the record, Jackson fails to mention the surface tension of the substrate or any steps taken to alter it, so it cannot possibly anticipate the claimed invention.

² See Ex parte Levy, 17 USPQ2d 1461, 1464 (BPAI 1990) and Section 2112, MPEP generally.

Likewise, claims 28 and 29 add the requirement for a mineral filler to form a non-smooth outer surface. Penz et al. is cited as disclosing a glass mat reinforced thermoplastic suitable for the production of paintable parts comprising a thermoplastic matrix polymer, one or more glass mats, and a fine-particle mineral fiber. The position taken is that "[s]ince both Jackson et al and Penz et al. are from the same field of endeavor, the purpose disclosed by Penz et al. would have been recognized in the pertinent art of Jackson et al."

The difficulty is that a skilled artisan would not combine Jackson and Penz et al. to arrive at the present invention. Specifically, one of ordinary skill in the art would not use the teaching of Penz et al. to include a mineral filler in the chemical composition of the polymeric coating to create a non-smooth surface in combination with Jackson, when in fact Jackson expressly teaches that such a feature is not a desirable attribute of a wall covering (see, e.g., col. 2, lines 5-12). Accordingly, Jackson and Penz et al. are simply not properly combinable, and even if combined do not lead to the inventions of claims 28 and 29.

Dependent claim 35 also requires that the polymeric material comprises approximately a 45/5/50 by weight mixture of high-density polyethylene, titanium dioxide, and a dispersion, said dispersion comprising of ground calcium carbonate and ground titanium dioxide in high density polyethylene. Neither Jackson nor Penz et al. discloses the use of titanium dioxide, as claimed. Furthermore, Jackson specifically requires a plastisol as a component of the polymer coating, which by definition includes a plasticizer. Such is clearly excluded by the plain terms of claim 35 which does not recite a plasticizer as a part of the 100 weight percent of the polymeric material. Accordingly, withdrawal of the rejection is in order.

The final Action also includes a final rejection of claim 36 as anticipated by Jackson "as further evidenced by" the Abstract of WO 95/07946. Despite this rejection, that Office Action points to nothing in Jackson that in any way discloses, teaches, or suggests the claimed rigid fiber tissue or mat. Indeed, this reference can be even considered to teach away from such a wall covering (see, e.g., col. 2, lines 39-41, "The hydroentangled

nonwoven substrate is a . . . soft fabric . . . ") (emphasis added). Accordingly, Applicant respectfully submits that the final rejection of claim 36 is improper and that it should be allowed, along with claims 2-13 and 22 which all now depend from claim 36.

Applicant also adds new claims 37-40 for consideration. Claim 37 reads on a fiber reinforced polymeric wall covering material comprising a non-woven fiber tissue or mat having an inner side and an outer side. A thermoplastic polymer coating applied to the outer side of the rigid non-woven fiber tissue or mat provides a roller paintable, visible outer surface. To facilitate roller painting, this surface has a surface tension of at least approximately 30 dynes/cm, which improves paint adhesion.

As noted above, Jackson is completely silent as to a wall covering including the claimed surface tension or even a desire for improving paint adhesion. Thus, it simply cannot anticipate claim 37 or render it obvious. None of the other cited patents is believed to supply the necessary missing teaching, either. Accordingly, the allowance of claim 37 is in order.

New claim 38 reads on a fiber reinforced polymeric wall covering material comprising a non-woven fiber tissue or mat having an inner side and an outer side and a thermoplastic polymer coating applied to the outer side and providing a roller paintable, visible outer surface. The polymeric coating comprises approximately a 45/5/50 by weight mixture of high-density polyethylene, an opacifying agent, and a dispersion. The dispersion comprises ground calcium carbonate and ground titanium dioxide in high density polyethylene. Claim 39 further requires that the opacifying agent is titanium dioxide.

As acknowledged throughout the past actions, Jackson requires the use of a plastisol composition, which by definition must include a plasticizer. In stark contrast, claim 39 excludes a plasticizer by requiring a 45/5/50 by weight mixture of high-density polyethylene, an opacifying agent, and a dispersion. As noted above, Jackson also teaches the use of titanium oxide, rather than titanium dioxide, and thus does not disclose each and every limitation of claims 38 or 39. Accordingly, Jackson cannot anticipate or render

obvious these claims, and none of the other cited references is believed to supply the necessary missing teachings that would do so, either.

Finally, new claim 40 requires a thermoplastic polymer with a mineral filler forming a visible outer, roller paintable surface of a wall covering with a non-woven tissue or mat having a visible inside surface as well. As noted above, Jackson specifically extols a smooth outer surface, and concomitantly disparagers a non-smooth outer surface. Thus, it very clearly teaches away from the invention of claim 40. As for Gundberg, Penz et al. and the other references of record, none disclosed the claimed combination, and otherwise cannot be properly combined with Jackson to arrive at this invention. Accordingly, the allowance of claim 40 is in order.

In view of the foregoing amendments and remarks, Applicant submits that claims 1-13, 22-36, and 37-40 are allowable over the cited prior art and respectfully requests favorable treatment. In the event the Examiner agrees, Applicant will also submit the information necessary to address the Section 112 rejection made with respect to dependent claim 8. In the meantime, the Examiner is invited to telephone the Applicant's undersigned attorney at (740) 321-7167 if any unresolved matters remain, and may debit any fees due from Deposit Account 50-0568.

Respectfully submitted,

By: 
Maria C. Gasaway
Reg. No. 51,721

Dated: 10-26-05

Owens Corning
Patent Dept. Bldg. 11
2790 Columbus Road
Granville, Ohio 43023
(740) 321-7213